

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed December 1, 2004. At the time of the Office Action, Claims 1-40 were pending in the Application. Applicant amends Claims 13 and 40 without prejudice or disclaimer. The amendments to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 101 Rejection

The Examiner rejects Claims 13-24 and 40 under 35 U.S.C. §101 because they purportedly are directed to non-statutory subject matter. In particular, the Examiner asserts that the method steps can be practiced mentally in conjunction with pen and paper. Applicant is unaware of "pen and paper" java processing, but would welcome the opportunity to be taught how such would even be possible. As a courtesy to the Examiner, Applicant has offered a minor amendment, which is not associated with issues of patentability, to make the operation of some of the pending claims abundantly clear.

Section 112 Rejection

The Examiner rejects Claims 1-40 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner takes issue with the term "source." Applicant proffers that usage of the term "source" is proper, as it is clearly identified and supported in the corresponding Specification (e.g. see page 7: lines 1-9).

The Examiner also identifies "business logic process" as being potentially problematic. The term "business logic process" is also clearly supported in the Specification, as it relates to logic associated with a business process. Applicant suggests the Examiner review page 6 of the corresponding Specification (e.g. lines 23-32) for clarification. If the Examiner continues to have difficulty with this term, Applicant recommends the Examiner to consult his SPE.

Section 103 Rejections

The Examiner rejects Claims 1-5, 7, 10-117, 19, 22-29, 31, and 34-38 under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/0046240 issued to Graham et al. (hereinafter "*Graham*"). The Examiner rejects Claims 6, 18, 30, and 39 under 35 U.S.C. §103(a) as being unpatentable over *Graham* in view of U.S. Patent No. 6,769,123 issued to Chan (hereinafter "*Chan*"). The Examiner rejects Claims 8-9, 20-21, 32-33, and 40 under 35 U.S.C. §103(a) as being unpatentable over *Graham* in view of U.S. Patent No. 6,480,860 issued to Monday (hereinafter "*Monday*"). These rejections are respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.¹

It is respectfully submitted that Claim 1 is patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation. For example, Independent Claim 1 recites:

An apparatus, comprising:

a framework operable to process a request that is communicated by a source *and that includes an associated functionality*, wherein the framework includes an abstraction layer operable to integrate a java object into the request such that *a generic term associated with the request is generated that is insulated from the functionality of the request*, and wherein the generic term is processed within the framework such that a response associated with the request is returned to the source.

In contrast to the teachings of Independent Claim 1, neither *Graham* nor *Chan* offer any architecture that offers a request that has any functionality: much less a functionality that is insulated from a generic term, as recited by Independent Claim 1. In the Office Action, the Examiner concedes that such a functionality feature is simply missing from the asserted

¹ See M.P.E.P. §2142-43.

references. (See Office Action: page 5.) In addition, the Examiner failed to offer any disclosure that relates to a functionality being insulated from a generic term. This absence of support in the cited references is presumably because these references lack these missing items. Evaluating *Graham* and *Chan* more closely confirms that these elements are simply not found therein. If neither of these references provides these elements (i.e. a generic term and/or a functionality), then the result is that neither reference can offer the transparency feature of the present invention. This transparency feature is described throughout the pending Application (e.g. see Specification at page 3: lines 17-25). For at least these reasons, Independent Claim 1 is patentably distinct from *Graham* and *Chan*.

Applicant also wishes to note that even if these elements of Independent Claim 1 were disclosed in the cited references, which they are not, usage of the *Graham* reference or of the proposed *Graham-Chan* or *Graham-Monday* combinations is still improper because the Examiner has not shown the required suggestion or motivation in *Graham*, *Monday*, or in *Chan*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.² Thus, the sheer fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.³

Nothing in *Graham*, *Monday*, or in *Chan* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.⁴ This is because the references fail to include the above-identified functionality and, therefore, are precluded from rendering the pending claims unpatentable. Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under

² M.P.E.P. §2143.01 (emphasis in original).

³ In *re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

⁴ If “common knowledge” or “well known” art is being relied on to combine the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. §2144.03.

M.P.E.P.⁵ guidelines and governing Federal Circuit case law.⁶ The M.P.E.P. consistently confirms that this approach is improper and, thus, it should not be used here.⁷ Moreover, under the M.P.E.P., such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and unknown authority.”⁸ Under such circumstances, the Examiner must point to some concrete evidence in the record in support of the rejection, rather than relying on an assessment of what is “well recognized” or what a skilled artisan would be “well aware.”⁹

In the context of the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. Therefore, Applicant respectfully submits that the Examiner has also failed to establish the second criteria for a prima facie case of obviousness.

Independent Claims 13, 25, 37, and 40 recite limitations similar, but not identical, to those recited in Independent Claim 1. Therefore, these claims are also allowable, for example, for the same reasons as identified above. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

Accordingly, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

⁵ See M.P.E.P. §2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

⁶ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

⁷ See M.P.E.P. §2145.

⁸ See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

⁹ See *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).

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15

PATENT APPLICATION
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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. However, if this is not correct, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,
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